

REMARKS

All pending claims 1-29 stand rejected under §101 as being directed to non-statutory subject matter, and under §103 as being obvious over Arsanjani ("Service Provider: A Domain Pattern and its Business Framework Implementation") in view of Shi ("A survey of manufacturing flexibility: Implications for e-business flexibility"). In response, Applicant has amended independent claims 1, 14, 23, and 28 without adding new matter. The amended claims define statutory subject matter, and are non-obvious over the cited references.

35 U.S.C. §101 Rejections

The governing test for determining the patentability of method claims under § 101 is the "machine-or-transformation" test. The machine-or-transformation test is a two-pronged inquiry that deems a process claim to be patentable subject matter if 1) it is tied to a particular machine; or 2) it transforms an article into a different state or thing. *In re Bilski*, 88 USPQ2d 1385, 1396 (Fed. Cir. Oct. 30, 2008).

In the instant application, claims 1 and 14 are independent method claims, and have been amended to explicitly recite that the method is performed on a computing device. Thus, the method claims are tied to a particular machine and satisfy the first prong of the inquiry. Additionally, however, claims 1 and 14 have also been amended to recite positive limitations in which the result of the method (i.e., the multi-domain patterns), as well as the domains from which the multi-domain pattern is derived, are displayed to the user on a display of the computing device. *E.g.*, *Spec.*, p. 3, ¶[0009] – p. 5, ¶[0013]. The Federal Circuit has determined that the electronic transformation of raw data into a particular visual depiction of specific physical objects on a display sufficiently renders a data processing claim eligible for patent protection under §101. *Id.* at 1397. Therefore, as amended, method claims 1 and 14

and their respective dependent claims satisfy both prongs of the "machine-or-transformation" test.

Claims 23 and 28 are independent apparatus claims, and thus are already tied to a particular machine. Claim 23 is directed to a system having specific hardware components (i.e., a server and a database communicatively connected to a controller). Claim 28 is now directed to a controller for a computing device configured to perform the claimed invention. Both independent claims 23 and 28 already recite displaying domain patterns associated with the apparatus to the user. Additionally, however, both claims have also been amended to now positively recite "[displaying the resultant] multi-domain pattern to the user." Therefore, claims 23-29 also recite subject matter that satisfies §101.

In light of these amendments and their accompanying remarks, Applicant respectfully requests the Examiner to withdraw the §101 rejections.

35 U.S.C. §103 Rejections

Claim 1, which stands rejected as being obvious over Arsanjani in view of Shi, is directed to a method that takes raw data (i.e., the defined hardware and software components of one or more identified domains) and outputs the hardware and software components from selected domains needed to build a resultant e-business system. Claim 1 recites, "displaying a plurality of domains on a display to a user, each said domain ... comprising a list of one or more patterns that identify hardware and software components associated with the domain." The Office Action acknowledges that Arsanjani does not teach or suggest domain-specific hardware components used to create a multi-domain pattern, as claimed. Therefore, Arsanjani cannot display such domains to a user, as claimed. Shi does not remedy this deficiency.

Shi discusses the importance of flexibility in e-business systems. Shi mentions information domains, but only to provide examples of the different functional areas included in a business model. Shi, p. 2 ¶¶2-3. Shi does not teach or suggest that the information domains

comprise "a list of one or more patterns that identify hardware and software components associated with the domain," as claimed in claim 1. Nor does Shi teach or suggest displaying such domains to a user so that a user can select the desired patterns from these domains to build an e-business system. This is because Shi is fundamentally concerned with the importance of *flexibility* in e-business systems to handle unforeseen changes that may affect an e-business system – not with the tools to design and build such a system. *Shi*, p. 2, ¶4.

Neither reference teaches or suggests, "displaying a plurality of domains on a display to a user, each said domain ... comprising a list of one or more patterns that identify hardware and software components associated with the domain." Since neither reference teaches or suggests this element of claim 1, any combination of the references also fails to teach or suggest this element of claim 1.

However, another reason that the cited references fail to render claim 1 obvious is that they do not teach or suggest, alone or in combination, "displaying said multi-domain pattern to the user," as recited in claim 1. As previously stated, Arsanjani does not teach or suggest domain-specific hardware components used to create a multi-domain pattern. As for Shi, it simply discusses the benefits of flexibility in e-business systems. It does not disclose the hardware and software components associated with the domains that are used to build the systems. Neither reference can teach or suggest, "displaying a multi-domain pattern to the user" that neither reference contemplates. Therefore, any combination of the references also fails to teach or suggest this element of claim 1. Accordingly, for at least the foregoing reasons, claim 1 and its dependent claims are non-obvious over the cited references.

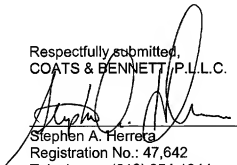
Claims 14, 23, and 28 also stand rejected as being obvious over Arsanjani in view of Shi for substantially the same reasons as those stated for the rejection of claim 1. Claim 14 is directed to a method of designing and building an e-business system. Claim 23 is directed to a system for designing and building an e-business system, and claim 28 is directed to a controller,

for a computing device. Each of these independent claims has been amended to contain language similar to that of claim 1, and thus, each is non-obvious over the cited references for substantially the same reasons as those stated above. Moreover, since the independent claims 14, 23, and 28 are non-obvious of the cited references, so, too, are their respective dependent claims.

Finally, Applicant notes that several claims have been amended to correct a minor grammatical error. No new matter has been added.

For the foregoing reasons, the references do not teach or suggest, alone or in combination, the pending claims. Accordingly, Applicant requests allowance of all pending claims.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read "Stephen A. Herrera", is written over a horizontal line. The signature is fluid and cursive.

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